



03-01-2002

TTAB

RP-118

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 75/899,810

Filing Date: January 21, 2000

Mark: ACOTEL and Design

Applicant: Acotel S.p.A.

Published: November 6, 2001

ALCATEL,

Opposer,

v.

ACOTEL S.p.A.,

Applicant.

Opposition No.

Box TTAB

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

**CERTIFICATE OF MAILING UNDER 37CFR 1.10**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express mail in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

*Bernard Molina* 3/1/02  
Bernard Molina  
Express Mail No. EL549422377US

**NOTICE OF OPPOSITION**

Alcatel, a French corporation, located at 30 Avenue Kleber, 75116 Paris, France (Opposer), believes that it will be damaged by registration of the mark ACOTEL and Design, shown in Intent to Use Application Serial No. 75/899,810 filed January 21, 2000, and hereby opposes the same.

As grounds for its opposition, Opposer, through its attorneys, alleges:

1. By the application herein opposed, Applicant seeks registration of the term ACOTEL and Design for the following goods and services: Electronic recording apparatus, electronic apparatus for transmission of telephone messages, electronic

apparatus for cellular telephone communications, electronic apparatus for computer aided transmission of messages; electronic apparatus for news agencies communication by computer terminals, electronic mail and facsimile transmissions in International Class 9; and telephone services for transmissions of messages, telephone services for cellular telephone communications, computer aided transmission of messages, services for rental of message sending apparatus, news agency communications by computer terminals, electronic mail and facsimile transmissions in International Class 38. (Applicant's Goods and/or Services).

2. Upon information and belief, Applicant has made no use of its mark in the United States prior to January 21, 2000, the date of filing of its Section 1(b) Intent to Use application.

3. Upon information and belief, Applicant has made no use of its mark in the United States.

4. Upon information and belief, Applicant does not have a bona fide intention to use Applicant's mark on or in connection with Applicant's Goods and/or Services in the United States.

5. Since long prior to Applicant's application filing date and/or date of first use, if any, and continuously to the present date, Opposer has used the designation ALCATEL alone and as a component of its other marks (Opposer's Marks) in the United States and throughout the world as a trademark on an extensive line of telephone and computer equipment and as a servicemark in connection with a wide range of telephone services and as a tradename for its business of designing, developing, manufacturing and

selling a wide range of telephone and computer products and services.

6. Opposer is the owner of U.S. Trademark Registration No. 996,963 for the mark ALCATEL for a wide range of goods in International Classes 7 and 9, including telecommunication and computer equipment and parts thereof.

7. Opposer is the owner of U.S. Trademark Registration No. 1,624,497 ALCATEL and Design for a wide range of electronic, telecommunication and computer equipment and parts thereof, in International Class 9.

8. The aforesaid U.S. Registration Nos. 996,963 and 1,624,497 are the exclusive property of Opposer and are in all respects valid and subsisting.

9. Opposer has used the mark ALCATEL as a "house mark" for its wide range of goods and services sold and rendered both in the United States and in approximately fifty foreign countries throughout the world. Thus, Opposer has obtained approximately twenty-five trademark registrations which incorporate its "house mark" ALCATEL in the U.S. as well as corresponding registrations in many foreign countries. As a result of the advertising, promotion and sale of its goods and services under and in connection with the marks ALCATEL and ALCATEL and Design throughout the world, Opposer's marks ALCATEL and ALCATEL and Design have acquired the status of Famous Marks whereby these marks enjoy a wide latitude of protection in the determination of likelihood of confusion.

10. The mark for the registration of which Applicant has applied, i.e., ACOTEL and Design, is substantially identical to and confusingly and deceptively similar, both visually and phonetically, to Opposer's trademarks/tradename ALCATEL and

ALCATEL and Design as likely to lead to and cause confusion and mistake in the minds of the purchasing public and to deceive said purchasing public as to the source or origin of Applicant's Goods.

11. The goods and services for which Applicant seeks registration of ACOTEL and Design and upon which and in connection with which Opposer's trademarks/tradename ALCATEL and ALCATEL and Design have been used and registered, are very similar and related, if not identical.

12. Upon information and belief, Applicant's Intent to Use and/or use of the mark ACOTEL and Design is with an intent to confuse and deceive the public into the mistaken belief that Applicant's goods sold and/or advertised by Applicant have their origin with Opposer, or that such goods are approved, endorsed or sponsored by Opposer, or are in some way associated with Opposer. Such intent to confuse is supported by the fact that, notwithstanding Applicant's knowledge with Opposer's prior adoption and use of Opposer's Marks on Opposer's goods in the U.S. and throughout the rest of the world, Applicant chose a mark in which both the word portion and the design portion respectively simulate and mimic both the word ALCATEL and the design component of Opposer's mark ALCATEL and Design respectively.

13. As a result of Applicant's registration and use of Applicant's mark on the goods and/or in connection with the services specified in Applicant's application, the public is likely to be confused and deceived into the mistaken belief that such goods and services sold and rendered and/or advertised by Applicant, have their origin with Opposer, or that such goods and/or services are approved, endorsed, or sponsored by

Opposer or are associated in some way with Opposer.

14. Opposer would be injured by the granting to Applicant of a Certificate of Registration for the mark ACOTEL and Design because that mark is so similar to Opposer's Marks that, when used in connection with Applicant's goods and/or services, it would be likely to cause confusion, or to cause mistake or to deceive, and would falsely suggest a connection with Opposer.

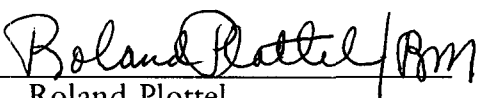
WHEREFORE, Opposer believes that it would be damaged by registration of Applicant's mark ACOTEL and Design and prays that the opposition be sustained and that registration to Applicant be refused.

Please charge the filing fee for this Opposition in the amount of \$600.00 to Deposit Account No. 16-2128. This Notice of Opposition is enclosed herewith in triplicate.

Dated: March 1, 2002

Respectfully submitted,

ROLAND PLOTTEL, ESQ.

By:   
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PATENT, TRADEMARK, COPYRIGHT  
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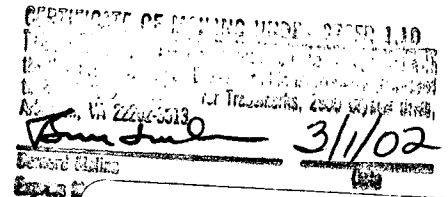
(212) 986-7410

VIA EXPRESS MAIL

Box TTAB FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

March 1, 2002

Re: Alcatel v. Acotel S.p.A.  
Notice of Opposition  
Serial No.: 75/899,810  
Mark: ACOTEL and Design  
Our File: RP-118



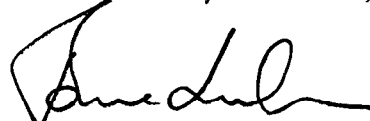
EL549422317US

Sir:

Enclosed herewith is the above-referenced Notice of Opposition in triplicate.

Please charge the filing fee in the amount of \$600.00 to Deposit Account No. 16-2128.

Respectfully submitted,

  
BERNARD MALINA

BM/it  
enclosures  
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